

## REMARKS

In view of the above amendments and foregoing remarks, favorable reconsideration in this application is respectfully requested. By this amendment, claims 1-20 were amended. Claims 1-20 remain pending in the application, including independent claims 1, 12 and 14.

### Information Disclosure Statements (IDS)

Applicant has received the initialed forms PTO-1449 filed Nov. 28, 2001, Jan. 2, 2003, Feb. 24, 2003 and March 20, 2003. However, the Examiner did not initial the three “other references” (the Eudora documents) that are listed on the form PTO-1449 filed on Nov. 28, 2001. In addition, Applicant has *not* received an initialed form for the IDS filed on June 20, 2002. Applicant notes that the Nov. 28, 2001 and June 20, 2002 forms PTO-1449 are available on PAIR, and therefore is not enclosing any additional copies of those documents. Applicant would appreciate if the Examiner would initial, sign and date those forms to acknowledge consideration of the cited references.

### Claim Rejections – 35 U.S.C. §101

The Examiner rejects claims 1-20 as being directed to non-statutory subject matter since they could include written software code on a piece of paper. Applicant submits that the Examiner’s rejection is incomplete since the Examiner does not cite any PTO guideline or

caselaw that suggests that written software code is non-statutory subject matter. Applicant has amended the claims to more particularly state that the invention is for a computer program (which includes both mail programs and mail services) (claim 1), electronic mail message (claim 12) and computer software application (claim 14). It is respectfully submitted that the rejection be withdrawn. Should this rejection be repeated, Applicant requests that the Examiner more completely state the rejection by citing authority and make the rejection non-final so that the Applicant has an opportunity to respond to the rejection.

Claim Rejections – 35 U.S.C. §§102/103

The Examiner rejects claims 1-2, 5-18 and 20 under 35 U.S.C. §102 as anticipated by Shaw (U.S. Patent No. 6,247,045), rejects claims 3 and 4 as obvious in view of Shaw, and rejects claim 19 as obvious over Shaw in view of Thurlow (U.S. Patent No. 6,456,879).

With respect to claim 1, the Examiner indicates that Shaw teaches a first email (Fig. 8A) having a first message (element 800) and a second email (Fig. 8A) having a second message (element 802). Thus, the Examiner is reading a single element of Shaw (Fig. 8A) on two elements (*i.e.*, both the first and second emails) of the claimed invention. Shaw does not show two emails, each having its own message. Rather, Shaw shows a single email having a message 800 and a message object 802. The present invention has several advantages over Shaw, including that the various messages are more easily viewed, and created, there is less chance that a message will go to an incorrect recipient, and a recipient will not be able to hack into a

message object not intended for that recipient. In addition, Shaw requires more complicated processing – involving the use of special styles, buffers, and address lists – in order to format the message and message object. (*See* col. 7, lines 1-14)

Accordingly, claims 1 and 14 have been amended to indicate that the second email is separate from the first email. Shaw does not teach that the message object 802 is separate from the message 800. In fact, Shaw teaches exactly the opposite – namely, that the message object 802 is an integral part of the message 800. As shown in Fig. 8A of Shaw, the message objects 802, 804, 806 are located within the message 800 – the large box represents that both the message 800 and message object 802 are enclosed together, and the message objects 802, 804, 806 are positioned between the message (*i.e.*, after the text “If you have questions concerning our release of this product, please let me know.”) and the signature block (*i.e.*, “Julie Key”). Shaw specifically keeps the message objects 802, 804, 806 within the message 800, and instead differentiates those from the message 800 by use of colors. As such, Shaw teaches away from the claimed invention, and claims 1 and 14 are patentable over Shaw.

In addition, dependent claim 2 has been amended to indicate that the first email is attached to the second email. By integrating the message object 802 with the message 800, Shaw teaches away from the message object 802 forming an attachment to the message 800.

Dependent claim 8 has been amended to indicate another technique for displaying the email, whereby the messages are displayed by respective tabs. This claimed feature is also not taught by Shaw.

Dependent claim 11 has been amended to indicate that the first email has a first address field and the second email has a second address field. Shaw does not provide an address field with the message object 802. Though Shaw has separate TO and CC fields, it does not have a first and second email, each with its own address field and message, as claimed. Instead, Shaw modifies a conventional email to include a message object 802 that is displayed only to certain ones of the email recipients. At best, Shaw shows a single email, but does not teach two emails that are associated with one another, as presently claimed. Accordingly, it is respectfully submitted that claim 11 is further patentable over Shaw.

With respect to claim 12, the Examiner indicates that the “Fig. 8A element ‘big solid line outside box’” reads on the claimed primary window and the “Fig. 8A element ‘dotted-line inner box’” reads on the claimed secondary window. Contrary to the Examiner’s assertions, Shaw does not use windows to differentiate its message 800 from its message object 802. Rather, Shaw utilizes different colors to differentiate those items. The Examiner appears to confuse the dashed lines shown in Fig. 8 of Shaw as representing windows, when in fact they were intended by Shaw to indicate color. Color is not usually suitable for PTO drawings (pursuant to MPEP §608.02 and 37 C.F.R. §1.84(c), “[o]n rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent . . . .”). Accordingly, Shaw conveyed the use of color in the invention by the use of dashed lines. Those dashed lines are not windows (as further noted in section 608.02, dashed lines are hidden lines). It is respectfully submitted that the Examiner misconstrued those dashed

lines based on impermissible hindsight gleaned from Applicant's own invention to reconstruct the claimed invention.

Hence, Shaw does not teach or suggest that separate windows are used. The dashed lines were used to represent the various colors used in the invention. The dashed lines do not form a part of the invention and are not displayed to the user. Nowhere in the description does Shaw discuss the use of separate windows, and there is no motivation in Shaw for one of ordinary skill in the art to use windows. To the contrary, Shaw uses colors to differentiate the message 800 from the message object 802, which negates the need for a window. The claimed use of windows provides a much better system, enabling an improved creation, display, processing and manipulation of messages. Consequently, Shaw does not teach each and every feature of claim 12, such that the claimed invention is patentable over Shaw.

Claims 1 and 14 have been further amended to require that the processing occur "substantially simultaneously." The term "substantially" has been added to account for the fact that processing may not occur exactly at the same time. For instance, one message or email may be processed before or after another message or email, but still be within the scope of the invention.

With respect to claim 19, the Examiner relies on Thurlow to teach the use of tabs. However, there is nothing in either Shaw or Thurlow to suggest that the tabs of Thurlow can be used for the message and message object of Shaw. Shaw is already distinguishing its message objects by different colors, so there is no need to use separate windows or tabs. Moreover,

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neither Shaw nor Thurlow teach or suggest the use of tabs to view separate messages. Shaw displays the message 800 at the same time it displays the message object 802 (see Figs. 8B, 8C, 8D), not separately.

In the event there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that the prosecution of this application may be expedited.

Respectfully submitted,

By: 

Peter S. Weissman  
Reg. No. 40,220

2912 Upton St., N. W.  
Washington, D.C. 20008  
Telephone: (202) 244-4212  
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